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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,920	09/23/2003	David W. Morris	20366-066001; PP23362.000	2631
7590 07/10/2007				
Lisa E. Alexander Sagres Discovery, Inc. c/o Chiron Corporation P.O. Box 8097 Emeryville, CA 94662-8097		EXAMINER HARRIS, ALANA M		
		ART UNIT	PAPER NUMBER	
		1643		
		MAIL DATE	DELIVERY MODE	
		07/10/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/669,920

Applicant(s)

MORRIS ET AL.

Examiner

Alana M. Harris, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61, 67, 69-72 and 74-84 is/are pending in the application.
- 4a) Of the above claim(s) 82-84 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 61, 67, 69-72 and 74-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments and Amendments

1. Claims 61, 67, 69-72 and 74-84 are pending.
Claims 68 and 73 have been cancelled.
Claims 61, 74 and 81 have been amended.
Claims 82-84, drawn to non-elected inventions are withdrawn from examination.
Claims 61, 67, 69-72 and 74-81 are examined on the merits.

Withdrawn Rejections

Claim Rejections - 35 USC § 112

2. The rejection of claims 61, 67, 69-72 and 74-81 under 35 U.S.C. 112, first paragraph, **NEW MATTER REJECTION** as failing to comply with the written description requirement is withdrawn in view of Applicants' assertions and amendments to the claims. Claims 68 and 73 have been cancelled.
3. The rejection of claims 61, 67, 69-72 and 74-81 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn in light of Applicants' arguments and amendments to the claims. Claims 68 and 73 have been cancelled.

Claim Rejections - 35 USC § 102

4. The rejection of claims 61, 67, 69-72 and 80 under 35 U.S.C. 102(b) as being anticipated by Salomon et al. (Endocrine-Related Cancer 7: 199-226, 2000) is withdrawn in light of Applicants' amendments to the claims. Claim 68 has been cancelled.
5. The rejection of claims 61, 67, 71, 72, 75, 76 and 80 under 35 U.S.C. 102(b) as being anticipated by Guc et al. (Eur. J. Haematol 64(1): 3-9, January 2000) is withdrawn in light of Applicants' amendments to the claims. Claim 68 has been cancelled.
6. The rejection of claims 61, 67, 69-72, 74-76, 80 and 81 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent number 6,569,662 B1 (filed July 19, 2000) is withdrawn in light of Applicants' amendments to the claims. Claims 68 and 73 have been cancelled.

Maintained and New Grounds of Rejection

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
8. Claims 61, 67, 69-72 and 74-81 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method for diagnosing

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lymphoma, carcinoma, breast cancer or colon cancer comprising detecting evidence of differential expression of complement receptor type 1 (CR1) gene in a patient sample, wherein evidence of differential expression is detected by measuring the level of an expression product of CR1 and wherein the expression product is a mRNA having a sequence of SEQ ID NO: 1320, wherein evidence of differential expression of the CR1 gene indicates that the patient has lymphoma, carcinoma, breast cancer or colon cancer, does not reasonably provide enablement for the said method measuring a full complement of the mRNA sequence of SEQ ID NO: 1320 (CR1). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

In essence, mRNA is art known as a single-stranded RNA molecule that is synthesized during transcription and is complementary to one of the strands of double-stranded DNA. A protein encoded from the mRNA, based on translation of the complementary sequence from 5' to 3', would not bear any resemblance to the protein encoded from SEQ ID NO: 1320 and hence would not be applicable to the claimed method.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alana M. Harris, Ph.D. whose telephone number is (571) 272-0831. The Examiner works a flexible schedule, however she can normally be reached between the hours of 7:30 am to 6:30 pm with alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry R. Helms, Ph.D. can be reached on (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ALANA M. HARRIS, PH.D.

PRIMARY EXAMINER


Alana M. Harris, Ph.D.

02 July 2007